

Docket No. 928073-92490



16/5
2/2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE THE APPLICATION OF

Edward M. Lichten

SERIAL NO.: 09/198,798

FILED: November 24, 1998

FOR: Use of Testosterone to Treat Impaired
Glucose Tolerance and Insulin Resistance
and Method for Screening for Insulin
Resistance in Adult Onset Diabetes and
Syndrome X

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) Examiner: Barbara P. Badio
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) Group Art Unit No. 1616
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to " Director of Patents and Trademarks, P.O. Box 1450, Alexandria, VA 22313-1450", on September 9, 2003.

Name of person signing Deborah E. Dudek

Signature Deborah E. Dudek

LETTER

Honorable Director of
Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Accompanying this letter is a copy of the reconstructed file of the above-identified patent application, along with a signed Revocation of Power of Attorney and Appointment of New Attorney authorizing the undersigned to prosecute this Application on behalf of Applicant. As stated in the e-mail from Margaret Stevens dated August 21, 2002 (appended as Exhibit A to Applicant's Remarks Regarding Reconstruction of File), the application was flagged lost on August 20, 2002.

The purpose of this letter is to request that the Examiner called the undersigned at (312) 214-4812 after she has reviewed the enclosed documents. The Response to the Final Office Action filed by Applicant's prior attorney before the application was lost was not accompanied by a Notice of Appeal. Applicant's present attorney wants to discuss with the Examiner the timing of a response to the next action by the Examiner, if a response is required.

September 9, 2003

Respectfully submitted,

A handwritten signature in black ink that reads "Howard B. Rockman". The signature is written in a cursive style with a horizontal line underneath the name.

Howard B. Rockman
Attorney for Applicant
Registration No. 22,190

Barnes & Thornburg
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Chicago, Illinois 60690-2786
(312) 214-4812
(312) 759-5646 (fax)
hrockman@btlaw.com



Margaret.Stevens@US
PTO.GOV

08/21/2002 08:30 AM

To: supadhye@sonnenschein.com
cc: Paula.Hutzell@USPTO.GOV, Helen.Childs@USPTO.GOV
Subject: RE: Lost File 09/198,798

TECH CENTER 1600 2900

DEC 11 2002

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I am acknowledging receipt of your e-mail.

The application was flagged lost on August 20th. If the file is not found within one month from August 20th, the Office will take action to reconstruct the file.

Thank you for sharing such detail information on the above identified application. I will kept you updated on the progress of your inquiry.

-----Original Message-----

From: supadhye@sonnenschein.com [mailto:supadhye@sonnenschein.com]
Sent: Tuesday, August 20, 2002 4:53 PM
To: margaret.stevens@uspto.gov
Subject: Lost File 09/198,798
Importance: High

I am referred to you by Ms. Pettus who indicated that the Office has officially flagged this file as Lost. The serial no. is 09/198,798 (inventor: Dr. Edward Lichten). I am also referred to you by Examiners Dees, Dickinson, and Richter, who have indicated that either you or Ms. Pettus can help.

She recommended that I give you timelines or other identification to help.

1. The Office mailed a Final Office Action dated 21 Feb. 2001 to the wrong address. It was mailed to the Michigan firm. The 6 month date was 21 August 2001 to respond. No response was ever filed because the Action was sent to the wrong address.
2. On 06 Sept. 2001, I received a phone call from Examiner Badio (the examiner in charge of case), who inquired about whether any abandonment was intentional. I explained what had happened that no Action was ever received.
3. I filed a Petition to Revive on 14 Sept. 2001 and included yet another Change of Address Notification.
4. The Office acted on the Petition (obviously meaning that the Office received the Petition and the Change of Address). Ms. Cecilia Tsang, on behalf of Director Doll, acted on the Petition and GRANTED it in Petition Decision dated 14 Jan. 2002.
5. The Petition Decision, although Granted, was still sent to another wrong address. Ms. Tsang sent the Decision and the revived Final Office Action, to Ms. Emily Haliday, c/o the Law Office of Johnathon Quine in Alameda, California.
6. I have no idea who Mr. Quine or Ms. Haliday are.
7. Notwithstanding the second mistake in mailing addresses, Ms. Haliday sent the Action and Decision to the Michigan firm. The Michigan firm sent the documents to me.
8. The re-set Final Office Action date was reset to the Petition Decision date of 14 Jan. 2002, which meant that a Response was due by 14 April 2002.
9. On 12 April 2002, I responded to the Final Office Action by filing a

EX. A

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DEC 11 2002

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Amendment After Final. Included with that submission was yet another Revocation of the Power of Attorney, a new Power of Attorney, and an address change. I received a Post Card acknowledgement dated 22 Feb. 2001 stamped from the PTO's OIPE JC-44 office.

10. I am informed by Ms. Pettus and others in Group 1600 that the last entry in the PTO Docket system is the Final Office Action date of 21 Feb. 2001.

11. I am informed by Ms. Pettus and others in Group 1600 that the Office has no record of:

- a. any Notice of Abandonment being sent, if any was sent
- b. my Petition to Revive dated 14 Sept. 2001
- c. the Office's own Petition Decision adjudicated by Ms. Tsang of Group 1600
- d. no record of my Amendment After Final filed on 12 April 2002

12. Therefore, according to the Office, the last "thing" done in this file was to issue the 21 Feb. 2001 Final Office Action. The office allegedly having not received any responses or petitions, a position that is clearly wrong, marked the file as Abandoned.

13. I have contacted the Office on numerous occasions inquiring about the status of the file, why it was abandoned, why there is no record of my or the Office's own correspondence, and where the file is.

14. I am now reliably informed by many people that the file is LOST.

15. I can reconstruct the file if necessary and am willing to do so on an expedited basis.

Please investigate if you wish the file reconstructed and whether yet another Petition to Revive is necessary.

I appreciate receiving a return email so that I know you received this.

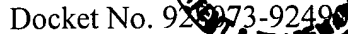
Many thanks,

Shashank Upadhye
Reg. No. 48,209

Shashank Upadhye
Patent Attorney
Sonnenschein, Nath, and Rosenthal
8000 Sears Tower
Chicago, IL, USA 60606
312-876-2622
312-876-7934 (fax)
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CONFIDENTIALITY NOTE:

This e-mail and any attachments are confidential and may be protected by legal privilege. If you are not the intended recipient, be aware that any disclosure, copying, distribution or use of this e-mail or any attachment is prohibited. If you have received this e-mail in error, please notify us immediately by returning it to the sender and delete this copy from your system. Thank you for your cooperation.



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Name of person signing Deborah E. Dudek

Signature

Person signing Deborah E. Dudek

REMARKS REGARDING RECONSTRUCTION OF FILE

Dear Sir:

- I. Submitted herewith is a Revocation of Power of Attorney and Appointment of New Attorney duly executed by the Applicant, granting the undersigned the authority to further prosecute the above-identified patent application.
- II. The above-identified patent application file has apparently been lost at the USPTO. By e-mail dated August 21, 2002, Ms. Margaret Stevens of the USPTO advised Mr. Shashank Upadyhe, Applicant's prior counsel, that the subject application was flagged as lost on

August 20, 2002 (Ex. A), and that if not found in one month from August 20, 2002, the USPTO would take action to reconstruct the file. The undersigned contacted Mr. Upadyhe on February 7, 2003, and was advised that he had not received any communication from the USPTO regarding reconstruction of the application file. Between August 20, 2002 and the present, the Applicant has appointed the undersigned as new counsel, as set forth in the enclosed Revocation of Power of Attorney and Appointment of New Attorney.

III. In an effort to reconstruct the file, Applicant submits the following documents constituting the file of the above-identified patent application:

- A. Patent application and five (5) sheets of drawings as originally filed on November 24, 1998, claiming priority of Provisional Application Serial No. 60/066,504, filed November 24, 1997.
- B. Filing receipt received by Applicant's then attorneys, Gifford, Krass et al. on March 17, 1999.
- C. Restriction Requirement, mailed December 23, 1999.
- D. Response to Restriction Requirement, dated January 24, 2000.
- E. Amended Information Disclosure Citation form PTO-A820 (no date).
- F. Office Action mailed April 25, 2000 requesting designation of additional claims reading on the elected species for examination.
- G. Response to Election of Species mailed June 26, 2000.

- H. First Office Action mailed August 15, 2000 acting on the merits of the elected claims, with attached Examiner's notations on the Information Disclosure Citation.
- I. Request for Extension of Time, mailed December 15, 2000, to respond to first Office Action.
- J. Transmittal Letter and Response to First Office Action, mailed December 15, 2000.
- K. Final Office Action mailed February 21, 2001.
- L. Office Action mailed September 21, 2001 with attached Notice of Abandonment.
- M. Petition Decision from John Doll, Director, Technology Center 1600 dated January 14, 2002, granting Applicant's "Petition to Revive Abandoned Patent Application for Failure to Respond to Office Action" filed September 21, 2001, and setting a due date of April 14, 2002 for Applicant's response to the Final Rejection of February 21, 2001. A copy of Applicant's "Petition to Revive" is not in the file presently in the possession of the undersigned, however an attempt will be made to locate same and furnish it to the Examiner. Note that the Petition Decision was mailed to an incorrect address.
- N. Transmittal Letter mailed April 12, 2002, "Revocation of Power of Attorney" and "Power of Attorney."
- O. Amendment and Response to Final Office Action mailed April 12, 2002, certificate of mailing is on Transmittal Letter (Item N).
- P. E-mail communications between Applicant's prior attorney, Shashank Upadhye, and Margaret Stevens dated August 20 and 21, 2002. Ms. Stevens' comment

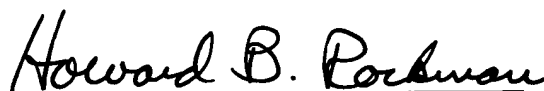
confirms that file Serial No. 09/198,798 was flagged as lost on August 20, 2002.

In response to this information, Applicant submits the enclosed reconstructed file.

The status of the Application, as now reconstructed, requires the Examiner to consider and respond to Applicant's Amendment and Response to Final Office Action, mailed April 12, 2002. Favorable action is solicited.

September 9, 2003

Respectfully submitted,

A handwritten signature in black ink that reads "Howard B. Rockman". The signature is written in a cursive style with a horizontal line underneath the name.

Howard B. Rockman
Attorney for Applicant
Registration No. 22,190

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FILING RECEIPT



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTORNEY DOCKET NO.	DRWGS	TOT CL	INT
09/198,798	11/24/98	1614	\$845.00	LIC-10002/03	0	1	1

GIFFORD KRASSS GROH SPRINKLE PATMORE
ANDERSON & CITKOWSKI P.C.
280 N OLD WOODWARD AVENUE
SUITE 400
BIRMINGHAM MI 48009-5394

Receipt is acknowledged of this patent application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Application Processing Division's Customer Connection Branch within 10 days of receipt. Please provide a copy of the Filing Receipt with the changes noted thereon.

Applicant(s) EDWARD M. LICHTEN, BLOOMFIELD HILLS, MI.

CONTINUING DATA AS CLAIMED BY APPLICANT-
PROVISIONAL APPLICATION NO. 60/066,504 11/24/97

IF REQUIRED, FOREIGN FILING LICENSE GRANTED 03/11/99 ** SMALL ENTITY **
TITLE
USE OF TESTOSTERONE TO TREAT IMPAIRED GLUCOSE TOLERANCE AND INSULIN
RESISTANCE AND METHOD FOR SCREENING FOR INSULIN RESISTANCE IN ADULT
ONSET DIABETES AND SYNDROME X

PRELIMINARY CLASS: 514

RECEIVED
MAR 17 1999
GIFFORD, KRASS, GROH, SPRINKLE,
ANDERSON & CITKOWSKI, P.C.

DATA ENTRY BY: WILSON, PAMELLA

TEAM: 12 DATE: 03/11/99

✓ B